REMARKS

This is intended as a full and complete response to the Office Action dated December 6, 2004, having a shortened statutory period for response set to expire on March 6, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claims 5-9, 11, and 21-31 are pending in the application. Claims 5-9, 11, and 21-31 remain pending following entry of this response. Claims 5, 11, 21, and 26 have been amended. Applicants submit that the amendments do not introduce new matter.

Claim Rejections - 35 U.S.C. § 102

Claims 5-9, 11, 21-24 and 26-31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Hekmatpour* (U.S. Patent No. 5,799,292) (hereinafter "*Hekmatpour*").

Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, *Hekmatpour* does not disclose "each and every element as set forth in the claim". For example, *Hekmatpour* does not disclose that rendering a Web page includes scrolling the Web page. The Examiner takes the position that *Hekmatpour* discloses "scrolling" because "the actual contents of the web portions are "scrolled" onto the display according to the arranged order." The Examiner further states "[b]y 'scrolling', the Examiner is referring to the moving, flipping, jumping from page to page, section to section, or topic to topic in the web document."

Respectfully, the Examiner errs in his interpretation of scrolling. It is well established that the meaning of scrolling is "the act of sliding a horizontal or vertical

Page 8

432636_1

PAGE 9/12 * RCVD AT 2/2/2006 9:32:37 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-6/24 * DNIS:2738300 * CSID:7136234846 * DURATION (mm-ss):03-46

presentation of content, such as text, drawings, or images, across a screen or display window." (*See* http://en.wikipedia.org/wiki/Scrolling)   Sliding a document is not equivalent to "moving, flipping, jumping from page to page, section to section, or topic to topic" in a document. Examiner further argues that scrolling can mean moving "pages" of a web document to different locations within a document. Examiner states:

> For example, if it is determined that page X of a web document is most interested to the user than page Y then page X will be "scrolled" or "positioned" on the display screen. Page Y will be the next in the display order.

However, this is also contrary to the common meaning of the term scrolling. The common meaning of scrolling does not include re-"positioning" an element or "page" of a document with respect to other elements or "pages" within the document. As mentioned before, the well known or common meaning of scrolling is sliding an entire document horizontally or vertically, not re-"positioning" one "page" within the document reference to other "pages" within the document.

Furthermore, the Examiner's interpretation of the term scrolling is contrary to the meaning of the term used in the reference itself. Multiple locations within *Hekmatpour* refer to scrolling as navigation through elements within a document rather than repositioning elements with respect to other elements within the document. (See, e.g., 7:31-33, 10:13-16, 10:30-31). Thus, *Hekmatpour* itself is contrary to the Examiner's interpretation.

Further, scrolling is recited in the present claims as an aspect of *rendering* a document or web page, which is a programmatic function. Scrolling in *Hekmatpour* is defined as a user function. (See, e.g., 7:31-33, 10:13-16, 10:30-31)

While believed to be unnecessary since the automated aspect of the scrolling is already implicit in the claims for the reasons given above, Applicants, nevertheless, have amended the claims to make explicit that the scrolling is automated.

Further, *Hekmatpour* does not disclose each and every element of the claims, 5, 11, 21 and 26, as amended. Claims 5, 11, 21 and 26 as amended add the additional

Page 9

432636_1

limitation of "where the user can scroll the Web page upwards to bring the portion of the page previously positioned outside the viewable area into the viewable area". In *Hekmatpour* when objects are rendered they are moved to the top of the subject window.(8:49-51) In *Hekmatpour*, if all of the relevant objects are at the top of the window, it is not possible in *Hekmatpour* to scroll upwards after the page has been rendered. Conversely, the amended claims add the additional limitation of allowing the user to at least scroll upwards. This functionality is not allowed in *Hekmatpour* as it is precisely the intention of *Hekmatpour* to eliminate scrolling altogether. (7:30-32) Therefore, *Hekmatpour* does not disclose an essential element of the claim.

The dependent claims are believed to be allowable by virtue of their dependence from a respective allowable independent claim. Accordingly, separate arguments with respect to the dependent claims are not necessary.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

Claim Rejections - 35 U.S.C. § 103

Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hekmatpour*. Applicants respectfully traverse this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *See* MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP § 2143. The present rejection fails to establish at least the third criterion. Specifically, *Hekmatpour* was discussed and overcome above. Therefore, Applicants submit that the claims are patentable over *Hekmatpour* and request allowance of the same.

432636_1

PATENT
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PS Ref. No.: IBM2K0066

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

Conclusion

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

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Page 11

432636_1